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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. : 09/821,195
Applicants : Timothy C. Loose
Wayne H. Rothschild
Norman R. Wurz
Filed : March 29, 2001
Title : Gaming Machine With An Overhanging Touch Screen
TC/A.U. : 3712
Examiner : Mosser, Robert E.
Docket No. : 47079-00086
Customer No. : 30223

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Signature (Deborah Ricks)

Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Sir:

This Appeal Brief is filed pursuant to the Applicants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 1-11 in an Office Action dated January 10, 2006. A Notice of Appeal was filed May 10, 2006, concurrent with a pre-appeal brief request for review. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on June 20, 2006, recommending that the appeal proceed to the Board.

The due date for this Appeal Brief is one month from the mailing date of the Notice of Panel Decision from Pre-Appeal Brief Review (i.e., July 20, 2006) in accord with the PTO policy

on pre-appeal brief requests outlined in the July 12, 2005, OG Notice concerning the same, and this paper is being timely filed via express mail pursuant to 37 C.F.R. 1.10.

I. REAL PARTY IN INTEREST

The real party in interest is WMS Gaming Inc., a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 800 South Northpoint Boulevard, Waukegan, IL 60085

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

III. STATUS OF CLAIMS

The claims, which are attached as Appendix A, have the following status:

Claims 1-11 are currently pending in the above-referenced application and are the subject of the present appeal. No claims have been allowed.

IV. STATUS OF AMENDMENTS

No amendments have been submitted or entered subsequent to the Final Office Action dated January 10, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed generally to a wagering gaming machine.

According to one embodiment of the invention a gaming machine (10; FIG. 1) is controlled by a processor (20; FIG. 2) that acts in response to a wager (*see, e.g.*, page 4, lines 2-4). The gaming machine (10) includes a display (11; FIG. 2) and a unitary touch screen (12; FIGS 1, 3)(*see id.* at lines 4-10). The display (11) includes both a video portion (14; FIGS 1, 3) and a non-video portion (15; FIGS 1, 3) (*see also id.* at lines 6-7), both of which are overlapped by the unitary touch screen (12)(*id.* at lines 7-9). The video portion (14) displays a plurality of

symbols indicating a randomly selected outcome of a wagering game (*see, e.g.*, page 6, line 32 to page 7, line 2; page 8, lines 7-13; FIGS 1, 3). The video portion (14) includes player-selectable first indicia that are selectable via the unitary touch screen (12)(*see, e.g.*, page 5, lines 2-5). The non-video portion (15) includes permanent player-selectable second indicia that are selectable via the unitary touch screen (*see, e.g.*, page 5, lines 5-10).

According to another embodiment of the invention, a gaming machine (10; FIG. 1) is controlled by a processor (20; FIG. 2) that acts in response to a wager (*see, e.g.*, page 4, lines 2-4). The gaming machine (10) includes a display (11; FIG. 2) includes both a video portion (14; FIGS 1, 3) and a non-video portion (15; FIGS 1, 3) (*see also id.* at lines 6-7). A unitary touch screen (12; FIGS 1, 3)(*see id.* at lines 4-10) is also provided and overlaps both the video portion (14) and non-video portion (15) of the display (11)(*see, e.g.*, page 4, lines 7-9). The video portion (14) includes player-selectable first indicia that are selectable via the unitary touch screen (12)(*see, e.g.*, page 5, lines 2-5). The non-video portion (15) includes permanent player-selectable second indicia that are selectable via the unitary touch screen (*see, e.g.*, page 5, lines 5-10). The non-video portion (15) includes an artwork panel (*see, e.g.*, page 5, lines 5-8) and the second indicia are selectively illuminated by lights located behind the artwork panel to indicate which of the second indicia are active and can be selected by a player (*see, e.g., id.* at lines 10-15). Each of the second indicia are illuminated independently of other second indicia. *Id.*

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3 and 5-9 are patentable under 35 U.S.C. §103(a) in view of the combination of U.S. Pat. No. 5,769,716, to Saffari et al. (“**Saffari**”) and European Patent No. EP0789338 to Bruzzese (“**Bruzzese**”).

2. Whether claims 4 and 11 are patentable under 35 U.S.C. §103(a) in view of the combination of **Saffari** and **Bruzzese** and further view of U.S. Patent No. 5,033,744 to Bridgeman et al. (“**Bridgeman**”).

3. Whether claim 10 is patentable under 35 U.S.C. §103(a) in view of the combination of **Saffari** and **Bruzzese** and further view of U.S. Patent No. 6,089,976 to Schneider et al. (“**Schneider**”).

VII. ARGUMENT

Appellant respectfully submits that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention for want of the requisite facts and lack of the requisite realistic motivation to combine the applied references in the proposed manner. The Examiner committed legal error in failing to consider potent indicia of non-obviousness of record stemming from a clear teaching away from the claimed invention. The Examiner further committed legal error in failing to consider the failure of the applied prior art to recognize, address or even offer a solution to the problem addressed and solved by the claimed invention.

1. CLAIMS 1-3 AND 5-9 ARE PATENTABLE UNDER 35 U.S.C. §103(A) IN VIEW OF THE COMBINATION OF SAFFARI AND BRUZZESE

A. THE COMBINATION OF SAFFARI AND BRUZZESE FAILS TO TEACH AND SUGGEST EACH AND EVERY ELEMENT OF THE CLAIMS

In the Final Office Action (*see* page 3, ¶ 2), the Examiner alleges that **Saffari** teaches an electronic video wager system incorporating a video portion with a reel game (*citing* FIG. 3; col. 1, lines 33-55) that displays a plurality of symbols indicating a randomly selected outcome of a wagering game and a separate non-video portion (*citing* col. 3, lines 2-5 and reference numerals 522, 523). The Examiner further alleges that the video portion contains an integrated touch

screen display and player-selectable indicia (*citing* col. 2, line 64 to col. 3, line 2) as well as permanent second indicia (522). The Examiner acknowledges that **Saffari** is silent as to the implementation of the permanent indicia as player-selectable indicia and the incorporation of a unitary touch screen across both the video and non-video portions of the display.

To make up for the admitted deficiency of **Saffari**, the Examiner cites **Bruzzese** for an alleged teaching of a unitary touch screen (34) including permanent player-selectable indicia (*see* page 3, ¶ 3 of Final Office Action)(*citing* FIGS. 3-4; col. 3, lines 9-39). The Examiner alleges that this touch screen (34) “spans across both the immediately adjacent game outcome display (44) and non-game outcome portions of the display.”

The Examiner concludes and alleges that “[i]t would have been obvious . . . to have incorporated the touch screen configuration of Bruzzese as taught above into the video game machine with touch screen of Saffari in order to reduce the device manufacturing cost as taught by Bruzzese (col. 2:18-24).” (*see* page 3, ¶ 4 of Final Office Action).

Appellant respectfully submits that **Saffari** and **Bruzzese**, whether taken singly or in combination, fail to teach or suggest all of the features of claims 1-3 and 5-9.

Saffari discloses, as noted by the Examiner, an embodiment comprising a touch screen configured such that the user may select one of the three columns 304 by pushing on a corresponding touch-sensitive region of the screen 322a, 322b, 322c. In such an embodiment, the only touch-sensitive regions of the screen are the portions 322a, 322b, 322c, each labeled “PRESS FOR SYMBOL TO FALL” disposed beneath the columns 304 (*see* col. 2, line 64 to col. 3, line 2; FIGS. 3A-3F). The touch-sensitive portions 322a, 322b, 322c (or alternatively buttons) are provided so that the user is enabled to select a column in which a displayed symbol 332 is positioned (*see, e.g.*, col. 4, lines 15-17).

Saffari fails to disclose or suggest, however, a video portion configured to display a plurality of symbols indicating a randomly selected outcome of a wagering game, the video portion including player-selectable first indicia selectable via said unitary touch screen. With reference to page 5, lines 2-5 of the Appellant's specification, the video portion 14 of the display 11 is described to include, in at least some aspects, graphical or static player-selectable first indicia that are selectable via the unitary touch screen 12 (*see, e.g.*, FIG. 4, depicts player-selectable first indicia including a pipe 80, a phonograph 82, cheese wheel 84, and hat 86). To the contrary, **Saffari** does not disclose or suggest, for example, the claimed video portion including player-selectable first indicia selectable via the unitary touch screen. The touch-sensitive portions 322a, 322b, 322c, disclosed by **Saffari** and noted by the Examiner are not in a video portion of the display 302. Rather, the only video portions of the display 302 disclosed by **Saffari** appear to include the symbol positions of rows 312a-c and columns 304a-c, and, for the sake of argument, perhaps timer 310.

Bruzzese is unable to make up for this deficiency of **Saffari**. **Bruzzese** discloses a gaming machine 30 comprising a conventional mechanical spinning reel gaming machine 10 comprising a mechanical spinning reel assembly 18 (*see* page 2, col. 2, lines 46-53). In play of the gaming machine, "a player presses the screen 32 at a 'touch point' in the region of the desired displayed indicia/icons to effect the respective machine operation, that action being signalled by the touch screen assembly 34 to a game controller," which causes the reels 18 to spin (*see* page 3, col. 3, lines 34-40). **Bruzzese** discloses a touch screen 34 and a graphical display 38 comprising a flat front screen 16 and "touch screen circuitry 34" bonded thereto and an adhesive graphic transfer 36 attached to a back side thereof (*see* page 3, col. 3, lines 12-19). Five upper window portions 44-52 (FIG. 4) are provided to permit a player to view the mechanical reels 18 disposed

behind the flat front screen 16 (*see id.* at lines 21-33). Mechanical reels are not merely a preferred embodiment of **Bruzzese**, but are, instead, an intrinsic feature of the invention of **Bruzzese**. Specifically, **Bruzzese** discloses that gaming machines providing for touch-screen control experience difficult technical problems associated therewith (*see* page 1, col. 1, lines 25-36) and teaches that “there still is a significant demand amongst players of gaming machines for the older-style spinning reel machine,” expressly stating that “[t]he present invention broadly provides a mechanical spinning reel gaming machine that incorporates touch screen controls.” (*see id.* at lines 41-43). **Bruzzese** does not, therefore, disclose or suggest a video portion including player-selectable first indicia selectable via the unitary touch screen, as recited in claims 1-3 and 5-9, as noted above.

Bruzzese thus does not disclose or suggest, for example, the claimed video portion including player-selectable first indicia selectable via the unitary touch screen. Instead, even if this Honorable Board were, *arguendo*, to accept the Examiner’s assertions regarding **Bruzzese** (*i.e.*, that **Bruzzese** discloses permanent player-selectable indicia as set forth in page 3, ¶ 3 of the Final Office Action), Appellant respectfully submits that **Bruzzese** cannot be reasonably said by the Examiner to disclose or suggest, for example, a video portion including player-selectable first indicia selectable via said unitary touch screen, as claimed.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). In this case, the Examiner has failed to establish *prima facie* obviousness of claims 1-3 and 5-9, as the Examiner has failed to establish that the combination of **Saffari** and **Bruzzese** discloses or suggests, for example, a video portion including player-selectable first indicia selectable via said unitary touch screen, as claimed.

Therefore, claims 1-3 and 5-9 are respectfully submitted to this Honorable Board be non-obvious over the combination of **Saffari** and **Bruzzese** under 35 U.S.C. § 103(a).

B. Bruzzese Teaches Away From The Proposed Combination

As noted above, mechanical reels are an intrinsic feature of the invention of **Bruzzese**. Specifically, **Bruzzese** addresses the “significant demand amongst players of gaming machines for the older-style spinning reel machine” and “provides a mechanical spinning reel gaming machine that incorporates touch screen controls.” (*see id.* at lines 41-43).

The recited video portion of the display displays a plurality of symbols indicating a randomly selected outcome of a wagering game and is further configured to include player-selectable first indicia selectable via said unitary touch screen. **Bruzzese** expressly prohibits, through its use of the mechanical reels 18 and disavowal of video monitors to graphically represent spinning reels (*see, e.g.*, col. 1, lines 25-42), the use of a “video portion” for display of the random outcomes (*i.e.*, the outcomes of the spinning reels).

Thus, it is respectfully submitted that not only does the combination of **Saffari** and **Bruzzese** fail to teach and suggest every element of the rejected claims under 35 U.S.C. § 103(a), but also that the Examiner has failed to consider evidence of teaching away of such combination and modification.

Thus, the objective of **Bruzzese** is at odds with the objective of **Saffari**. A person of ordinary skill in the art would not have looked, in isolation (*i.e.*, without the benefit of Appellant’s disclosure), to combine the features of **Saffari** and **Bruzzese** in the manner alleged by the Examiner, since they conflict with one other on this point.

C. INDICIUM OF NONOBVIOUSNESS

Further to the above, Appellant respectfully submits that the problem addressed and solved by a claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

The present invention addresses and solves problems attendant upon conventional gaming machine designs. Contrary to conventional designs, the claimed invention non-video portion 15 of the display 11 is overlaid by the touch screen and is disposed adjacent the video portion 14 (*see, e.g.*, page 5, lines 16-20 of Appellant's specification). The touch screen 12 is larger than the video portion 14 of the display 11 so as to allow not only the touch screen 12 to overlay the video portion 14 of the display 11, but also allows a portion of the touch screen 12 to overlap the non-video portion 15 where a back-lit glass panel displays static game features such as player-selectable indicia, text, or numerical figures without requiring a video monitor to be present at that portion of the display (*see id.* at lines 20-26). Placement of the touch screen 12 so that it partially overlaps a non-video portion 15 of the display 11 allows game manufacturers and creators to devote more space on the video portion 14 of the display 11 to dynamic graphical images and game icons while maintaining display space for static features (*see id.* at lines 26-30). Game manufacturers and creators are able to locate static features such as images, text, numerals, and icons on the non-video portion 15 of the display 11, reducing or eliminating the amount of

essential display space from the video portion 14 of the display 11 that is occupied by static features (*see* page 5, line 30 to page 6, line 1). Thus, since the touch screen 12 overlaps the non-video portion 15 of the display 11, wherein some static player-selectable indicia are located, the video portion 14 of the display 11 is maximized for dynamic game play, while providing a lower incremental cost (*see* page 6, lines 1-23).

Saffari does not disclose a unitary touch screen overlapping both a video portion and a non-video portion, as claimed, nor is such alleged by the Examiner. Instead, the Examiner cites **Bruzzese** as disclosing a unitary touch screen (34) overlapping a video portion and a non-video portion. However, as noted above, **Bruzzese** does not even disclose or suggest a video portion including player-selectable first indicia selectable via the unitary touch screen. Thus, **Bruzzese** fails to address the problem addressed and solved by the claimed invention. Although it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant (*see, e.g., In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), the combination of elements selected from each of the references in combination must have been suggested by or from the references and must intrinsically represent, as a whole, the claimed invention. “[I]t is this invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. § 103.” *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977)(emphasis in original).

In the present case, **Bruzzese** does not itself suggest (or disclose) a video portion including player-selectable first indicia selectable via the unitary touch screen. **Bruzzese’s** statement of *belief* that there could be a savings in manufacturing costs when touch screens are used in lieu of the circuitry and components of conventional pushbutton controls (col. 2, lines 18-23) does not, as espoused by the Examiner (*see* page 3, ¶ 2 of Final Office Action), disclose or

suggest a video portion including player-selectable first indicia selectable via the unitary touch screen. The advance taught by **Bruzzese** relates entirely to gaming machine manufacturers of “mechanical spinning reel machines” and the *potential* cost savings associated with use of touch screen icons at the bottom of screen 16 in lieu of dedicated push-buttons does not teach or suggest cost savings associated with moving permanent player-selectable second indicia out of a video portion of a display. **Bruzzese** cost reduction disclosure cannot be reasonably extrapolated to circumscribe Appellant’s claimed unitary touch screen which overlaps both a video portion and a non-video portion so as to optimize the video portion (*e.g.*, by providing permanent player-selectable second indicia in a non-video display portion). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Under such circumstances, the problem addressed and solved by the claimed invention merits consideration as a potent indicium of nonobviousness.

D. EQUIVALENCE OF BRUZZESE GRAPHICAL ELEMENT NOT ESTABLISHED

Further to the above, **Bruzzese** has not been shown to disclose or suggest a “unitary touch screen overlapping both said video portion and said non-video portion,” as claimed. As acknowledged by the Examiner, **Saffari** “is silent regarding . . . the incorporation of a unitary touch screen across both the video and non-video portions of the display” (*see* Final Office Action, page 3, ¶ 1). To make up for this acknowledged deficiency of **Saffari**, the Examiner appears to rely upon an implied equivalency, asserting that **Bruzzese** discloses “a unitary touch screen (34)” that “spans across both the immediately adjacent game outcome display (44) and non-game outcome portions of the display (“PLAY 1”).

However, **Bruzzese**, as **Saffari**, fails to teach or suggest that the asserted unitary touch screen (34) overlaps both a video portion and a non-video portion of the display. In fact, neither **Bruzzese** nor **Saffari** have been shown to provide player-selectable first indicia selectable via a unitary touch screen in a video portion of the display and permanent player-selectable second indicia selectable via the unitary touch screen in a non-video portion of the display. **Bruzzese** discloses a “graphical display 38” configured to show “available credits and other game functions, instructions or advertising” to the player (col. 3, lines 29-31).

However, this type of display element has not been shown by the Examiner to be an equivalent of the disclosed and claimed video portion. Although the Examiner’s rejection does not expressly rely on equivalence, the rejection is in fact premised upon an implied assertion of equivalence between the display element of **Bruzzese** and the disclosed and claimed video portion. In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Appellant’s disclosure or the mere fact that the components at issue may be functional or mechanical equivalents (which has not been established). *In re Ruff*, 256 F.2d 590 (CCPA 1958). In the present case, the graphical display 38 of **Bruzzese** has not been shown to teach or suggest the claimed video portion, nor does such graphical display 38 inherently comprise a video portion, as claimed.

For this reason as well, Appellant respectfully submits that the Examiner has failed to discharge the factual predicate required for a *prima facie* case of obviousness. Appellant submits that the Examiner’s conclusory statements, standing alone, are not “evidence.” *In re Dembiczak*, 175 F.3d 994, 999-1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Mere . . . conclusory statements, however, are not sufficient to establish a genuine issue of material fact.”);

McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Reversal of the Examiner's 35 U.S.C. § 103 rejection of claims 1-3 and 5-9 is requested for at least this reason.

2. CLAIMS 4 AND 11 ARE PATENTABLE UNDER 35 U.S.C. §103(A) IN VIEW OF THE COMBINATION OF SAFFARI, BRUZZESE, AND BRIDGEMAN

Claim 4 recites, further to claim 1, that the non-video portion includes an artwork panel and that the second indicia are “selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player.”

Claim 11 likewise recites that the non-video portion includes an artwork panel and the second indicia “are selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player, each of said second indicia being illuminated independently of other second indicia.”

Further to the remarks presented above, which are incorporated herein, Appellant respectfully submits that **Bridgeman** is unable to make up for the deficiencies identified above with respect to claims 1 and 3, from which claim 4 depends. **Bridgeman** is cited as disclosing “the use of illuminated mechanical switches in order to indicate to a player that a video gaming machine is ready to accept user input” (*citing* FIG. 2; col. 5, line 68 to col. 6, line 2). **Bridgeman** fails to teach or suggest, and has not been shown to teach or suggest, a “unitary touch screen overlapping both said video portion and said non-video portion,” or “a display including a video portion . . . wherein said video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game . . . said video portion including player-selectable first indicia selectable via said unitary touch screen” (claim 4). **Bridgeman**

also fails to teach or suggest the “unitary touch screen overlapping both said video portion and said non-video portion,” the “video portion including player-selectable first indicia selectable via said unitary touch screen,” a “non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen wherein said non-video portion includes an artwork panel,” or “second indicia . . . selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player, each of said second indicia being illuminated independently of other second indicia” (claim 11).

Accordingly, Appellant respectfully submits that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 has not been established at least for want of the requisite facts in view of the remarks above, which are omitted herein for brevity.

As to the purported motivation for combination, the Examiner concludes and alleges in the Final Office Action that “[i]t would have been obvious . . . to have incorporated the use of illumination to indicate the availability of a switch to accept inputs as taught by Bridgeman into the option of a touch screen located over artwork as taught by Saffari/Bruzzese in order to direct the user to game inputs only when said inputs are available” (page 4, ¶ 3).

Bridgeman discloses the lighting of buttons (*e.g.*, 56, 58, 60, 62, 66) on a front panel of the gaming machine (FIG. 1). However, **Bridgeman** fails to disclose or suggest the positioning of lights behind a portion of the claimed unitary touch screen which overlaps a non-video portion of the display, let alone behind an artwork panel associated with such touch screen.

Saffari and **Bruzzese** similarly have not been shown to disclose or suggest the positioning of lights behind a portion of the claimed unitary touch screen which overlaps a non-video portion of the display or behind an artwork panel associated with such touch screen. Instead, **Saffari** discloses buttons (*e.g.*, 322a-c in FIGS. 3A-3F or 522a-522c in FIG. 5) provided

on a display device 302 (*see, e.g.*, col. 2, line 66 to col. 3, line 10). In **Saffari**, each of the buttons 322a-c, 522a-522c is continuously active, to facilitate player selection, and **Saffari** does not teach or suggest illuminating these buttons, let alone “selectively” illuminating these buttons. **Bruzzese** similarly fails to teach or suggest any illumination for the buttons (not numbered) depicted at the bottom of screen 32 in FIG. 4, let alone behind graphic transfer 36 (*see, e.g.*, col. 3, lines 23-26). Tellingly, **Bruzzese** expressly notes “lower window portions 40, 42” and “upper windows 44-52” permit the player to view portions of the machine, such as the mechanical reels 18, behind the graphic transfer 36 (*see, e.g.*, col. 3, lines 27-33). No such “windows” in the graphic transfer 36 are provided with respect to the aforementioned buttons. Thus, it stands to reason that the buttons of **Bruzzese** are not illuminated. Moreover, **Bruzzese** fails to discuss any need for such illumination.

Accordingly, the sole nexus between the Appellant’s claimed subject matter and the applied prior art is the Examiner’s statement of rejection. None of **Saffari**, **Bruzzese**, and **Bridgeman** teach or suggest the claimed combination of elements. Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so. *See In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The showing must be clear and particular. *See, e.g., In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998).

In the present case, Appellant respectfully submits that the Examiner has merely advanced a conclusory statement and that this bald assertion, standing alone, does not constitute “evidence” supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). Appellant further submits, as previously noted, that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-site Corp. v. VSI Int’l Inc.*, *supra*.

Appellant therefore respectfully submits that the imposed rejection of claims 4 and 11 under 35 U.S.C. §103(a) for obviousness predicated upon **Saffari** in view of **Bruzzese** and **Bridgeman** is not factually or legally viable and reversal is requested at least upon the grounds noted above.

3. CLAIM 10 IS PATENTABLE UNDER 35 U.S.C. §103(A) IN VIEW OF THE
COMBINATION OF SAFFARI, BRUZZESE, AND SCHNEIDER

Claim 10 recites, further to claim 1, that “said video portion includes a display of a bonus game in response to a bonus outcome being achieved.”

Further to the remarks presented above, which are incorporated herein, Appellant respectfully submits that **Schneider** is unable to make up for the deficiencies identified above with respect to claim 1, from which claim 10 depends. **Schneider** is cited as disclosing the displaying of a bonus outcome in response to a bonus outcome being achieved. **Schneider**, however, fails to teach or suggest, and has not been shown to teach or suggest, a “unitary touch screen overlapping both said video portion and said non-video portion,” or “a display including a video portion . . . wherein said video portion displays a plurality of symbols indicating a

randomly selected outcome of a wagering game . . . said video portion including player-selectable first indicia selectable via said unitary touch screen.”

Accordingly, Appellant respectfully submits that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 has not been established at least for want of the requisite facts in view of the remarks above, which are omitted herein for brevity.

VIII. CONCLUSION

Based upon the foregoing, Appellant submits that a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. §103 has not been established for lack of the requisite facts and realistic motivation. Moreover, upon giving due consideration to the problem addressed and solved by the claimed invention, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. §103. *Jones v. Hardy*, 727 F.2d 1524, 220, USPQ 1021 (Fed. Cir. 1984). Appellant, therefore, respectfully submits that the imposed rejections of claims 1-11 under 35 U.S.C. §103 for obviousness predicated upon the combinations of references noted above are not factually or legally viable.

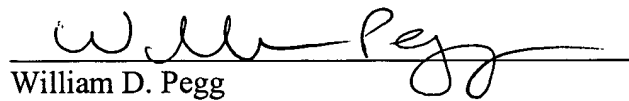
IX. PRAYER FOR RELIEF

Based upon the arguments submitted *supra*, Appellant respectfully submits that the Examiner has not established a *prima facie* basis to deny patentability to any of the claims under 35 U.S.C. §103. Appellant, therefore, respectfully solicits this Honorable Board to reverse each of the Examiner’s rejections.

The fee of \$500.00 required by 37 C.F.R. 41.20(b)(2) is enclosed herewith. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 10-0447 (Order No. 47079-00086) and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: July 20, 2006

A handwritten signature in cursive script, appearing to read "William D. Pegg", written over a horizontal line.

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| Index | Exhibits |
|-------------------------------------|----------|
| Claims Appendix | A |
| Evidence Appendix | |
| None | B |
| Related Proceedings Appendix | |
| None | C |
| | |

Listing of Claims:

1. (Previously Presented) A gaming machine controlled by a processor in response to a wager, said gaming machine comprising:
 - a display including a video portion and a non-video portion, wherein said video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game; and
 - a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen.
2. (Original) The gaming machine of claim 1, wherein said video portion and said non-video portion are immediately adjacent each other.
3. (Original) The gaming machine of claim 1, wherein said non-video portion includes an artwork panel.
4. (Original) The gaming machine of claim 3, wherein said second indicia are selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player.
5. (Original) The gaming machine of claim 3, wherein said second indicia are printed on said artwork panel.
6. (Original) The gaming machine of claim 1, wherein said second indicia are selected from a group consisting of a “Spin Reels” button, a “Bet Per Line” button, a “Max Bet Spin” button, a “Select Lines” button, a “Collect” button, a “Help” button, and a “Pay Table” button.
7. (Original) The gaming machine of claim 1, wherein said non-video portion is located below said video portion.

8. (Original) The gaming machine of claim 1, wherein said first indicia vary in at least one of location and function depending upon a segment of a game being played on the gaming machine.

9. (Previously Presented) The gaming machine of claim 1, wherein said video portion includes a display of at least one of a reel game, a video card game, a video roulette game, and a video keno game.

10. (Previously Presented) The gaming machine of claim 1, wherein said video portion includes a display of a bonus game in response to a bonus outcome being achieved.

11. (Previously Presented) A gaming machine controlled by a processor in response to a wager, said gaming machine comprising:

a display including a video portion and a non-video portion; and

a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen wherein said non-video portion includes an artwork panel and said second indicia are selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player, each of said second indicia being illuminated independently of other second indicia.

Evidence Appendix

None. All evidence relied upon in Appeal Brief is of record and no evidence is being submitted herewith.

Related Proceedings Appendix

None. There are no related proceedings